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In re Application of
SIA, Charles D. Y. *et al*
U.S. Application No.: 09/914,205
PCT No.: PCT/CA00/00190
Int. Filing Date: 24 February 2000
Priority Date: 24 February 1999
Attorney Docket No.: 1038-1176 MIS
For: EXPRESSING GP140 FRAGMENT OF
PRIMARY HIV-1 ISOLATE

**DECISION ON
PETITION UNDER
37 CFR 1.47(a)**

This is a decision on applicants' "Petition under 37 C.F.R. 1.47(a)" filed on 24 May 2002.

BACKGROUND

On 23 January 2002, applicants submitted a declaration signed by four of the five co-inventors.

On 24 May 2002, applicants filed the instant petition which was accompanied by, *inter alia*, the petition fee of \$130.00, and a declaration of Reza Yacoob ("Decl.").

On 25 June 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) indicating that all 35 U.S.C. requirements were completed on 23 January 2002.

DISCUSSION

Completed 35 U.S.C. 371 Requirements

A review of the above-referenced application reveals that a declaration in compliance with 37 CFR 1.497(a) and (b) has not yet been submitted. The first named co-inventor has not signed a declaration and a petition under 37 CFR 1.47(a) has not yet been granted.

Therefore, the Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) mailed 25 June 2002 was sent in error, and is hereby **VACATED**.

R refusal to Join

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the \$130.00 petition fee has been paid.

With regard to item (3), applicants state that the last known address of the nonsigning co-inventor, Charles D. Y. Sia is:

133 Torresdale Avenue, Suite 901
Toronto, Ontario
Canada, M2R 3T2

However, applicants have not sufficiently met the requirements of items (2) and (4) of 37 CFR 1.47(a).

Concerning item (2), applicants submitted a declaration by Reza Yacoob of the Patents Department of Aventis Pasteur Limited explaining her efforts to obtain the signature of the nonsigning inventor, Mr. Sia. She states that "[o]n January 2, 2002, I arranged for a complete copy of the specification for this application including drawings to be couriered by Federal Express . . . to Charles D. Y. Sia at his last known address . . . along with a Declaration and Power of Attorney document, with a request that he execute and return the paper." Decl. at ¶ 3. Then Ms. Yacoob claims that "[t]he shipment was delivered on January 10, 2002 and signed for by Charles D.Y. Sia. The requested executed Declaration and Power of Attorney has been received from Charles D.Y. Sia." Id. Further she declares that since the nonsigning inventor terminated employment with Aventis Pasteur Limited on 28 September 2000, he has "consistently not returned papers required to be executed in connection with various patent application in which he is a named inventor. Id. at ¶ 4.

The statement by Ms. Yacoob that the requested executed declaration has been received from the nonsigning inventor does not make sense. If an executed declaration has been received, the instant petition under 37 CFR 1.47(a) is not required. Assuming Mr. Sia has not signed the declaration, applicants' burden in proving that an inventor refuses to join pursuant to item (2) of 37 CFR 1.47 is explained in section 409.03(d) of the MPEP which states, in part:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the

statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In this case, applicants must provide documentary evidence that Mr. Sia received a complete copy of the application. Copies of the documents submitted to Mr. Sia on 10 January 2002, and proof that it was received by Mr. Sia are required. Applicants should also provide copies of the documents returned by Mr. Sia. There is also no indication that the 37 CFR 1.47(a) applicant has attempted to contact Mr. Sia directly via the telephone and verified his refusal to cooperate. An attempt to contact Mr. Sia should be made and the facts should be made of record. For these reasons, Item (2) is not yet satisfied.

Regarding item (4), applicants included a declaration signed by four of the five co-inventors listed on the international publication on 23 January 2002 and again on 24 May 2002. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on each declaration.

However, applicants submitted one declaration and a portion of another declaration on both dates. On 23 January 2002 and 24 May 2002, applicants filed a declaration containing one page 1-3 of 4, and two page 4 of 4. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration, it is not clear what inventive entity was listed on the declaration signed by each co-inventor. Applicants must submit the complete declaration signed by each co-inventor. For this reason, item (4) is also not satisfied.

Thus, all of the requirements of 37 CFR 1.47(a) are not yet complete.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant

Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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